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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,037	07/15/2003	Randy A. Harris	29195-8222US1	8893
22918	7590	01/19/2006	EXAMINER	
PERKINS COIE LLP			UNDERWOOD, DONALD W	
P.O. BOX 2168			ART UNIT	
MENLO PARK, CA 94026			PAPER NUMBER	
			3652	
DATE MAILED: 01/19/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,037

Applicant(s)

HARRIS ET AL.

Examiner

Donald Underwood

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/31/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 47-53 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-27 and 36-40 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-15, 17-19, 28, 30-35, 41-44 and 46 is/are rejected.
- 7) ☒ Claim(s) 6, 16, 29 and 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>103105</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 47-53 stand withdrawn as being directed to a non-elected invention.

The restriction set forth a restriction between apparatus and method. Applicants elected the apparatus in the election filed 10/31/05. The restriction inadvertently included method claims 47-53 in the apparatus. Applicants' representative John Wechkin acknowledged the election of the apparatus and concurred with the above noted inadvertence in a telephone consultation on 01/12/06.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 5, 9, 12, 15, 18, 28, 32, 34, 41, 43 and 44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Jacoby, et al.

Inspection station 27 meets applicants' process station as broadly claimed.

Regarding claims 4, 5, 12, 28, 41 and 44, note stations 34, 35 and 36 carry work pieces after processing. Further regarding claims 4, 12, 28 and 44, the aligner station overlaps with stations 34, 35 and 36 since arm 22 services all of them.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 7, 8, 10, 11, 13, 14, 17, 19, 30, 31, 33, 35, 42 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacoby, et al. in view of Otwell, et al.

Regarding claims 2, 14 and 31, it would have been obvious to enclose the device in Jacoby in an enclosure as claimed in view of the teaching in Otwell to provide a cleaner environment.

Regarding claims 7, 8, 17, 33 and 42, it would have been obvious to provide plural pre-process stations and transfer devices in view of the teaching in Otwell to enhance production.

Regarding claims 10, 11, 19, 35 and 46, it would have been obvious to substitute any conventional process including those claimed for the process in Jacoby.

Regarding claims 13 and 40, support pins are conventional on work piece supports to minimize contamination and thus their use on the supports in Jacoby would have been obvious.

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Claims 6, 16, 29 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 20-27 and 36-40 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Underwood whose telephone number is 571-272-6933. The examiner can normally be reached on Mon-Thursday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 01/13/06
Donald Underwood
Primary Examiner
Art Unit 3652

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